UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/785,340	02/24/2004	Andrew D. Bocking	0590	8776

7590 03/20/2007

RICHARD V. WESTERHOFF
Eckert Seamans Cherin & Mellott, LLC
44th Floor
600 Grant St.
Pittsburgh, PA 15219

EXAMINER	
HEFFINGTON, JOHN M	
ART UNIT	**PAPER NUMBER**
2109	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/20/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/785,340	BOCKING, ANDREW D.	
	Examiner	Art Unit	
	John M. Heffington	2109	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *24 February 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-18* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-18* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *24 February 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *2 May 2005, 24 February 2004*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

This action is in response to the original filing of February 24, 2004. Claims 1-20 are pending and have been considered below.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Examiner's Note. The Applicant appears to be attempting to invoke 35 U.S.C. 112 6th paragraph in Claim 11 by using "means-plus-function" language. The Examiner notes that the "means" for performing the input function in the specification includes a key board, a track wheel, and an excape button. The input means passes the three prong test used to determine invocation of paragraph 6. Therefore 35 U.S.C. 112 6th paragraph has been successfully invoked for the input means. However, the only "means" for the first indicator means and the second indicator means appears to be software supporting a graphical user interface. While these features pass the first test of the three-prong test used to determine invocation of paragraph 6, since no other specific structural limitations are disclosed in the specification, these features do not meet the other tests of the three prong test. Therefore, 35 U.S.C. 112 6th paragraph has not been invoked when considering these features.

3. Examiner's Note. The Applicant appears to be attempting to invoke 35 U.S.C. 112 6th paragraph in Claims 12,15-18 by using "means-plus-function" language. However, the Examiner notes that the only "means" for performing these cited functions in the specification appears to be software supporting a graphical user interface. While the claims pass the first test of the three-prong test used to determine invocation of paragraph 6, since no other specific structural limitations are disclosed in the specification, the claims do not meet the other tests of the three prong test. Therefore, 35 U.S.C. 112 6th paragraph has not been invoked when considering these claims below.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-3,6,7 are rejected under 35 U.S.C. 102(e) as being anticipated by Hellebust (US 2005/0248437 A1).

Claim 1: Hellebust discloses a method including:

a. an indication of the presence of unread electronic messages received (paragraph 0011) [display of the wireless device may also be updated to reflect that a new (unread) message has arrived]

b. enabling scanning of the unread electronic messages received without reading (paragraph 0002) [a small screen that displays a few short lines of text..... To view each item that has been sent to the wireless device, the user generally must through a series of screens or menus]

c. altering said indication to provide an annunciation that some of the unread electronic messages received are new electronic messages that have been received since the unread electronic messages received were last scanned (paragraph 0011) [the display of the wireless device may also be updated to reflect that a new (unread) message has arrived]

Claim 2: Hellebust discloses a method as in claim 1 above including providing a visual display indicating the presence of unread electronic messages received (paragraph 0011) [The display of the wireless device may also be updated to reflect that a new (unread) message has arrived]

Claim 3: Hellebust discloses a method as in claim 2 above including altering the visual display (paragraph 0011) [display of the wireless device may also be updated to reflect that a new (unread) message has arrived]

Claim 6: Hellebust discloses a method as in claim 3 above including adding indicia of new unread electronic messages received (paragraph 0011) [The display of the wireless device may also be updated to reflect that a new message has arrived such as by the display of standard or user defined icons or sounds, the display of summarized message counts by type, or the display of the actual message itself as determined by the message priority and user defined settings.]

Claim 7: Hellebust discloses a method as in claim 3 above including providing a visual indication of a count of unread electronic messages received (paragraph 0017) [The display of the wireless device could show the number of messages...]

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 4,5,8,11-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hellebust(US 2005/0248437 A1) in view of Salmimaa (US 2002/0160817 A1).

Claim 4: Hellebust discloses a method including:

a. an indication of the presence of unread electronic messages received (paragraph 0011) [display of the wireless device may also be updated to reflect that a new (unread) message has arrived]

b. enabling scanning of the unread electronic messages received without reading (paragraph 0002) [a small screen that displays a few short lines of text..... To view each item that has been sent to the wireless device, the user generally must through a series of screens or menus]

c. generating an indication that new electronic messages have been received since the unread electronic messages received were last scanned (paragraph 0011) [display of the wireless device may also be updated to reflect that a new (unread) message has arrived]

d. providing a visual display indicating the presence of unread electronic messages received (paragraph 0011) [display of the wireless device may also be updated to reflect that a new (unread) message has arrived]

e. altering the visual display (paragraph 0011) [display of the wireless device may also be updated to reflect that a new (unread) message has arrived]

but does not disclose:

a. providing an icon indicating the presence of unread electronic messages, and,

b. altering the icon to indicate the presence of new electronic messages received.

Salmimaa discloses altering an icon to indicate the receipt of a new message [paragraph 0013, paragraph 0026]. Therefore, it would have been obvious to one having ordinary skill in the art for Hellebust to alter an icon to indicate the receipt of a new message. One would have been motivated to alter an icon to indicate the receipt of a message in order to concisely represent the receipt of a new message on the display.

Claim 5: Hellebust and Salmimaa disclose altering an icon to indicate the receipt of a new message as in claim 4 above and Salmimaa further discloses modifying icons "such that certain icons appear wider, taller, brighter, enhanced in color or tone, etc...." (paragraph 0013). Therefore it would have been obvious to one having ordinary skill in the art at the time of the invention for Hellebust to alter icons corresponding to new messages. One would have been motivated to modify icons corresponding to new messages in order to distinguish different categories of messages from each other.

Claim 8: Hellebust discloses a method including:

a. an indication of the presence of unread electronic messages received (paragraph 0011) [display of the wireless device may also be updated to reflect that a new (unread) message has arrived]
b. enabling scanning of the unread electronic messages received without reading (paragraph 0002) [a small screen that displays a few short lines of text..... To

view each item that has been sent to the wireless device, the user generally must through a series of screens or menus]

c. generating an indication that new electronic messages have been received since the unread electronic messages received were last scanned (paragraph 0011) [display of the wireless device may also be updated to reflect that a new (unread) message has arrived]

d. providing a visual display indicating the presence of unread electronic messages received (paragraph 0011) [display of the wireless device may also be updated to reflect that a new (unread) message has arrived]

e. altering the visual display (paragraph 0011) [display of the wireless device may also be updated to reflect that a new (unread) message has arrived]

f. providing a visual indication of a count of unread electronic messages received (paragraph 0017) [The display of the wireless device could show the number of messages...]

but does not disclose altering the visual display comprising at least one selected from a group comprising: bolding, flashing, changing the size, and changing the color of the count of unread electronic messages. Salmimaa discloses altering the visual display comprising at least one selected from a group comprising: bolding, flashing, changing the size, and changing the color of the count of unread electronic messages (paragraph 0013) [modifying icons "such that certain icons appear wider, taller, brighter, enhanced in color or tone, etc...."]. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention for Hellebust to alter the

visual display comprising at least one selected from a group comprising: bolding, flashing, changing the size, and changing the color of the count of unread electronic messages. One would have been motivated for to alter the visual display comprising at least one selected from a group comprising: bolding, flashing, changing the size, and changing the color of the count of unread electronic messages ~~in order to One would have been motivated to~~ And To modify icons corresponding to new messages in order to distinguish different categories of messages from each other.

Claim 11: Hellebust and discloses a system for managing electronic messages received, comprising:

a. A display (Hellebust: paragraph 0011) [The display of the wireless device may also be updated...]

b. a message list of electronic messages received with identification of those that are unread (Hellebust: paragraph 0002) [However, most wireless devices are only equipped with a small screen that displays a few short lines of text or small graphics. To view each item that has been sent to the wireless device, the user generally must scroll through a series of screens or menus...]

c. first indicator means on the display for indicating the presence of unread messages (Hellebust: paragraph 0011) [The display of the wireless device may also be updated to reflect that a new message has arrived...]

but does not disclose a second indicator means on the display comprising an alteration to said first indicator means to provide an annunciation of the presence of

new unread electronic messages received since the message list was last displayed. Salmimaa discloses an indicator means on the display comprising an alteration to said indicator means to provide an annunciation of the presence of new unread electronic messages received since the message list was last displayed (Salmimaa: paragraph 0013) [The display characteristics of the icons can be modified...]. Therefore it would have been obvious to one having ordinary skill in the art at the time of the invention for Hellebust to alter said indicator means to provide an annunciation of the presence of new unread electronic messages received since the message list was last displayed. One would have been motivated to alter said indicator means to indicate the presence of new messages.

Salmimaa further discloses an input means for selectively displaying the message list on the display (Salmimaa: paragraph 0038) [a user of a terminal can modify context values contained in the storage area using a keypad, cursor, stylus, or similar input device]. Therefore it would have been obvious to one having ordinary skill in the art at the time of the invention for Hellebust to use an input means for selectively displaying the message list on the display. One would have been motivated to use an input means for selectively displaying the message list on the display because it is common to include an input means on many wireless devices.

Claim 12: Hellebust and Salmimaa disclose a system for managing electronic messages received as in claim 11 above and Hellebust further discloses a system

wherein the first indicator means comprises a count of unread electronic messages displayed on the display in addition to the annunciation of the presence of new unread electronic messages received (Hellebust: paragraph 0017) [The display of the wireless device could show the number of messages].

Claim 13: Hellebust and Salmimaa disclose a system wherein the first indicator means comprises a count of unread electronic messages displayed on the display in addition to the annunciation of the presence of new unread electronic messages received as in claim 12 above and Salmimaa further discloses a system wherein the annunciation of the presence of new unread electronic messages received comprises an alteration to the count of unread electronic messages received (Salmimaa: paragraph 0013) [The display characteristics of the icons ban be modified...]. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention for Hellebust to alter the count of unread electronic messages received. One would have been motivated to alter the count of unread electronic messages received in order to indicate the count of new messages received.

Claim 14: Hellebustg and Salmimaa disclose a system wherein the annunciation of the presence of new unread electronic messages received comprises an alteration to the count of unread electronic messages received as in claim 13 above and Salmimaa further discloses a system wherein the alteration to the count comprises at least one of: bolding the count, flashing the count, changing the size of the count and changing the

color of the count (Salmimaa: paragraph 0013) [The display characteristics of the icons can be modified such that certain icons appear wider, taller, brighter, enhanced in color or tone, etc.]. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention for Hellebust to alter the count by at least one of: bolding the count, flashing the count, changing the size of the count and changing the color of the count. One would have been motivated to alter the count by at least one of: bolding the count, flashing the count, changing the size of the count and changing the color of the count to make the count indication more readily apparent.

Claim 15: Hellebust and Salmimaa disclose a system wherein the alteration to the count comprises at least one of: bolding the count, flashing the count, changing the size of the count and changing the color of the count as in claim 12 above (Salmimaa: paragraph 0013) [The display characteristics of the icons can be modified such that certain icons appear wider, taller, brighter, enhanced in color or tone, etc.]. The indicia are indicated by making the icons appear wider, taller, brighter, enhanced in color or tone, etc. as in claim 11 above.

Claim 16: Hellebust and Salmimaa disclose a system wherein the first indicator means comprises a count of unread electronic messages displayed on the display in addition to the annunciation of the presence of new unread electronic messages received as in claim 12 above, and Hellebust further discloses a system wherein the annunciation of the presence of new unread electronic messages received since the message list was

last displayed comprises means altering the message icon but do not disclose (Hellebust: paragraph 0013) [The display characteristics of the icons can be modified...] as in claim 12 above, but neither reference discloses a message icon on the display adjacent the count of unread electronic messages received. However, It would be obvious to one having ordinary skill in the art at the time of the invention to add a message icon on the display adjacent the count of unread electronic messages to Hellebust. One would have been motivated to add a message icon on the display adjacent the count of unread electronic messages to Hellebust so that the message icon could be displayed proximate to the count icon, thereby making it easier to read both icons simultaneously.

Claim 17: Hellebust and Salmimaa disclose a system wherein the annunciation of the presence of new unread electronic messages received since the message list was last displayed comprises means altering the message icon as in claim 16 above and Salmimaa further discloses a system providing alteration to the message icon comprises at least one of: bolding the icon, flashing the icon, changing the size of the icon and changing the color of the icon (Salmimaa: paragraph 0013) [The display characteristics of the icons can be modified such that certain icons appear wider, taller, brighter, enhanced in color or tone, etc.] AS IN CLAIM 11 ABOVE.

Claim 18: Hellebust and Salmimaa disclose a system wherein the first indicator means comprises a count of unread electronic messages displayed on the display in addition to

the annunciation of the presence of new unread electronic messages received as in claim 12 above and Hellebust further discloses a system wherein the second indicating means further comprises a second count, which is the count of the new unread electronic messages received (paragraph 0017) [The display of the wireless device could show the number of messages...]

8. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hellebust (US 2005/0248437 A1) in view of Salmimaa (US 2002/0160817 A1) as applied to claim 7 above, and further in view of Cowart (Mastering Windows 95).

Claim 9: Hellebust and Salmimaa disclose a method for providing an icon to indicate the presence of unread electronic messages (Hellebust: paragraph 0011) [The display of the wireless device may also be updated to reflect that a new message has arrived such as by the display of standard or user defined icons or sounds...] along with the visual indication of the count of unread electronic messages (Hellebust: paragraph 0017) [The display of the wireless device could show the number of messages..], and altering at least one of the icon and the count (Salmimaa: paragraph 0013) [The display characteristics of the icons can be modified...] as in claim 7 above, but do not disclose providing an unread mail icon indicating the presence of unread electronic messages. Cowart discloses providing an unread mail icon indicating the presence of unread electronic messages (Cowart: figure 15.10). Therefore, it would have been obvious to add providing an unread mail icon indicating the presence of unread electronic messages to Hellebust. One would have been motivated to provide an unread mail icon

indicating the presence of unread electronic messages in Hellebust in order to distinguish email messages from other types of messages.

Claim 10: Hellebust, Salmimaa and Cowart disclose a method for providing an unread mail icon indicating the presence of unread electronic messages as in claim 9 above and Hellebust further discloses a method wherein altering the display comprises adding to the visual display a second count of the new unread electronic messages since the last scan (Hellebust: paragraph 0017) [The display of the wireless device could show the number of messages...].

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John M. Heffington whose telephone number is (571) 270-1696. The examiner can normally be reached on Mon - Fri (Alternate Fridays off) 7:30 - 5:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jim Myhre can be reached on (571) 270-1065. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JMH
3/12/07

James Myhre
Supervisory Patent Examiner